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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/588,534

10/12/2006

Jean-Marie Gouot

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EXAMINER

SULLIVAN, DANIELLE D

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

06/24/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/588,534	<b>Applicant(s)</b> GOUOT ET AL.	
	<b>Examiner</b> DANIELLE SULLIVAN	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Applicant's amendments and arguments filed 03/16/2009 are acknowledged and have been fully considered. Claims 1-20 are pending. Claims 18-20 have been added in the amendment filed 3/16/2009.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moloney et al. WO 99/42447) in view of Brandes et al. (5,532,262).

### **Applicant's Invention**

Applicant claims a fungicidal composition comprising a) a pyridylethylbenzamide derivative of formula (I) and b) a compound capable of inhibiting mitosis and cell division selected from a benzimidazole derivatives thiopantate, thiopantate-methyl and diethofencarb. Claim 2 and 3 specify the p and q in formula I), respectively, is 2. Claim 4-7 specify X and Y in formula I), respectively are selected from halogen and haloalkyl, preferably, chlorine or trifluoromethyl. Claim 8, 9 and 18 specify formula I) is N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide. Claim 10, 11 and 19 specify b) is a benzimidazole derivative, preferably selected from benomyl, carbendazim and thiabendazole. Claim 12 specify b) is selected from diethofencarb.

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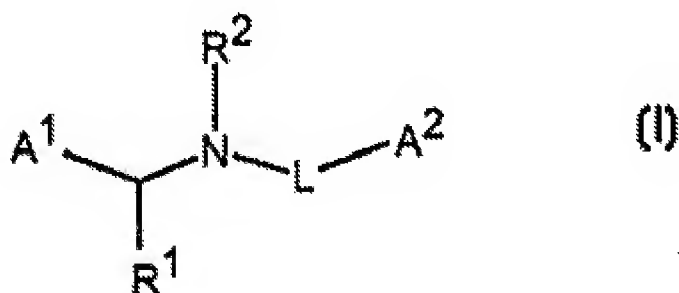
Claim 13, 14 and 20 specify and addition fungicide, preferably selected from iprodione and chlorotalonil. Claim 15 specify the composition comprises a support, carrier, filler and/or surfactant.

Applicants also claim a method of controlling phytopathogenic fungi in crops by applying the composition to the seed, plant, fruit or soil.

**Determination of the scope and the content of the prior art**

**(MPEP 2141.01)**

Moloney et al. teach the pyridylethylbenzamide derivative of formula (I) wherein A1 is a substituted 2-pyridyl, A2 is optionally substituted phenyl, L is  $-(C=O)-$ , R1 is hydrogen, and A2 is phenyl which can have up to five substituents (page 1, lines 1-20). Species of compounds 1, 3, 12 and 17 are obvious over the pyridylethylbenzamide derivative of formula (I). (See page 15).



The compound is used as a fungicide against mildews, rusts and other fungi (page 4, lines 20-30). The compound may be mixed with one or more insecticides, fungicides, plant growth regulator, etc. (column 5, lines 6-10). The composition is applied in the range of 0.0001 to 1 percent by weight (page 6, lines 34 and 35).

**Ascertainment of the difference between the prior art and the claims  
(MPEP 2141.02)**

Moloney et al. teach formula (I) as differing in structure. The alkylene group between the pyridyl group and the benzamide moiety taught by Moloney et al. is different from the methylene group disclosed in the present invention. However, the compounds are homologues that differ by a methylene linkage and it would have been obvious to one of ordinary skill in the art to synthesis homologues of this class of compounds and compositions because homologs are expected to exhibit the same biological property.

Also, Moloney et al. do not teach the additional fungicides include a compound capable of inhibiting mitosis and cell division selected from a benzimidazole derivative thiopanate, thiopanate-methyl and diethofencarb and the addition fungicide selected from iprodione and chlorotalonil. It is for this reason that Brandes et al. is joined.

Brandes et al. teach fungicidal compositions useful for the control of phytopathogenic fungi (column 1, lines 1-17). The compounds carbendazim (0.25 to 5 parts by weight), diethofencarb (0.5 to 5 parts by weight), iprodione (0.5 to 10 parts by weight), thiopanate, thiopanate-methyl (0.25 to 5 parts by weight), chlorothalonil (0.5 to 10 parts by weight) and benomyl are taught display very good fungicidal properties (column 3, line 20-25; column 4, lines 50-65; column 6, lines 19-35).

It would be prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose, "the idea of combining them

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flows logically from their having been individually taught in prior art.” In re Kerkhoven 205 USPQ 1069, (C.C.P.A. 1980). Thus, combining carbendazim, diethofencarb, iprodione, thiopante, thiopante-methyl and benomyl with formula (I) is obvious.

### **Finding of prima facie obviousness**

#### **Rationale and Motivation (MPEP 2142-2143)**

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Moloney et al. and Brandes et al. to utilize a compound selected from carbendazim (0.25 to 5 parts by weight), diethofencarb (0.5 to 5 parts by weight), iprodione (0.5 to 10 parts by weight), thiopante-methyl (0.25 to 5 parts by weight) and chlorothalonil (0.5 to 10 parts by weight) with formula (I). One would have been motivated to utilize these compounds because Brandes et al. teaches that they are known to display fungicidal properties and combining one fungicide with another is prima facie.

#### ***Response to Arguments***

Applicant's arguments filed 3/16/2009 have been fully considered but they are not persuasive. Applicants argue that the experimental data filed in co-pending application 10/524,345 shows unexpected results that demonstrate the fungicidal activity of the ethylene group linking the pyridyl and benzamide moiety with each other. Hence, Applicants believe they have discovered a novel and unobvious combination of fungicides that exhibit synergy. While the examiner notes the results the Examiner does not believe the data showing unexpected results is commensurate in scope with the claims.

The present claims are drawn to a combination of formula (I) and a compound capable of inhibiting mitosis and cell division. The specification only provides enablement for the combination of N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide and carbendazim in a ratio of 1:1. However, the results appear to show an additive effect. For example, where the dosage is 125 +125 of compound 1:Carbendazim,  $63 +16=79$ , which is an expected result of adding the efficacy values.

Furthermore, Applicant has not provided a proper side-by-side comparison of the present claims relative to the closest prior art Compound 1 of U.S. 6,503,933 and carbendazim. The unexpected results must be statistical and practical in significance. See MPEP 716.02(a). Furthermore, synergy is merely a property which may be expected or unexpected depending on the particular art, therefore it is the burden of applicant to establish that the results are in fact unexpected and unobvious. See MPEP 716.02(b). See also Ex parte Gelles, 22 USPQ2d 1318 (Bd. Pat. App. & Inter. 1992).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIELLE SULLIVAN whose telephone number is (571)270-3285. The examiner can normally be reached on 7:30 AM - 5:00 PM Mon-Thur EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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